

REMARKS

Reconsideration of the subject application in view of the present amendment is respectfully requested.

By the present amendment, the drawings have been amended to provide an element shown therein with a reference numeral, and the specification has been amended to make a reference to that reference numeral. Claim 1 has been canceled, claim 13 has been added, and claims 2-4 and 10-12 have been amended to make them dependent on the new claim.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

I. Amendment to the Drawings and the Specification

As noted above, the drawings (Fig. 1) and the specification has been amended to describe an element shown in the original drawings and provided it with a reference numeral.

It is specifically submitted that the foregoing amendment of the specification and drawing do not constitute new

It is a long held view that the amendments to the specification are proper when they conform to the original drawings. Thus, the District Court of Northern California stated:

An amendment does not constitute new matter where the amendment clarifies an inherent property of the invention as disclosed by the original application, or where it adds nothing to what a person skilled in the art would have learned from the original application, or where it includes matter clearly disclosed by drawings in the original application.

Corometrics Medical Systems Inc. v. Berkely Bio-Engineering, Inc., 193 U.S.P.Q. 467, 476 (DC N. Calif. 1977).

The same view has been expressed by the Ninth Circuit Court of Appeals that stated:

Resort may be made to the drawings to cure omissions in the description. Omark Industries, Inc. v. Textron, Inc., 216 U.S.P.Q. 749, 753 (9th Cir. 1982).

The foregoing decisions are consistent with the holding in Vas-Gath, Inc. v. Mahurkar, 19 U.S.P.Q. 2d, 1117 (Fed. Cir. 1991) that “[D]rawings alone may be sufficient to provide the “written description of the invention” required by §112, first paragraph.”

Approval of the amended Fig. 1 (replacement sheet, together with a letter to official Draftsperson being enclosed) is respectfully requested.

II. Rejection of Claims

The Examiner rejected Claims 1-12 under 35 U.S.C. § 103(a) as being unpatentable over Schulz et al. U.S. Patent No. 5,145,237 (Schultz) in view of Jenne, U.S. 4,508,181 (Jenne).

It is respectfully submitted that all of the Claims 2-13 are allowable over the prior art, including all of the prior art of record in this application.

Specifically, claim 13 recites a plurality of axial grooves (4) extending up to the chipping tip (3') and radially toward a core diameter, whereby the core diameter likewise tapers toward the workpiece end of the useful region (toward the tip).

As explained in the specification, with a plurality of axial grooves extending up to the workpiece end of the useful region, i.e. tip to the tip, a concave polygon cross-section is obtained along the entire longitudinal extent of the useful region, which results in a substantially constant self-sharpening action. The substantially constant self-sharpening action leads to a particularly high chipping capacity in the initial operational section, which is a primary object of the present invention.

Schulz does not disclose a point chisel the useful region of which is formed as a concave polygon, nor does Schulz disclose a core diameter tapering toward the

workpiece end of the useful region. In view of the above, it is respectfully submitted that Schulz neither anticipates nor makes obvious the present invention, as defined by claim 13.

Jenne is not believe to be pertinent to the present invention. Jenne relates to driving head for pneumatic pile drivers and is served as an attachment head for rods and pipes which are to be driven in pile drivers. The object of Jenne is to provide a driving head that in addition to providing an accurate travel, permits to reduce the resistance to entry of the driving head.

In Jenne, the object of the invention is achieved by providing axial grooves having a V-shaped cross-section, with the driving head being formed of a plurality of conical section which one offset in the manner of steps by jumps in diameter. The driving head of Jenne is designed for effectively splitting and removal of earth. No sharpening of cutting edges takes place in Jenne. Jenne relates to the tool for treating a Soft material (earth) and not a hard material (stone, concrete).

The case law holds

In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also

In re Deminski, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

Jenne is not in the field of applicant's endeavor, nor is Jenne pertinent to the problems the present invention is concerned with.

Even assuming *arguendo*, that Jenne is a pertinent reference, a *prima facie* case of obviousness has not been made.

Under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that the first element of *prima facie* obviousness has not been established.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting

supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992 (footnote omitted) (emphasis in original). See also *In re Sernaker*, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983); *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 U.S.P.Q.2d 1468, 1475 (Fed. Cir. 1988); *In re Laskowski*, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989); *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in Schulz and/or Jenne for their combination. A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness. MPEP § 2143.01 relying on *Ex Parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie* case of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or inference in the prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings.” *Id.* at 1301 (emphasis in original). No such evidence is presented in the Office Action.

The Office Action states that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the

shaft of Schulz with tapered shaft having axial grooves as taught by Jenne in order to kneads, pushes, displaces, plows through, splits, and chisel the ground in an optimum manner and hereby achieves a high travel accuracy at a simultaneously high speed.” However, the present invention is not directed to a tool for working the ground but is directed to a tool for working a hard material acting on a surface primarily with an active tip. It is noted that Jenne contains no disclosure whatsoever of the driving head being and capable of self-sharpening which is, as discussed above, the object of the present invention.

The Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record is any evidence, other than the PTO’s speculation (if it be called evidence) that one skilled in the art would have been motivated to make the modification of the prior art “necessary to arrive at the claimed invention. *In re Jones* 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

Accordingly, it is respectfully submitted that the combination of Schulz and Jenne would not be obvious and would not make the present invention, as defined by Claim 13 obvious, and it is respectfully submitted that Claim 13 is patentable over said combination.

Claims 2-12 depend on Claim 13 and are allowable for the same reason Claim 13 is allowable and further because of specific features recited therein which, when taken above and/or in combination with features recited in Claim 13, are not disclosed or suggested in the prior art.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail and addressed to:
Commissioner for Patents, P.O Box 1450, Alexandria, VA 22313-1450, on
October 29, 2004.



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In the Drawings:

Replace Fig. 1 with a new Fig. 1 enclosed herewith.